

REMARKS

Claims 1 – 22 remain in the application and stand rejected. Although this Response is being timely filed, the Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2179.

Claims 1 – 5 and 10 – 14 are rejected as being unpatentable under 35 U.S.C. §102(e) over newly cited published U.S. Patent Application No. 2004/0029598 to Guggisberg. Claims 6 – 9 and 15 – 22 are rejected under 35 U.S.C. §103(a) over Guggisberg in further combination with U.S. Patent No. 6,359,892 to Szlam. The rejection is respectfully traversed.

Guggisberg teaches “a method for transmitting short messages between computers in the Internet.” *See, e.g.*, paragraph 0001, lines 1 – 3. It is key to Guggisberg that “communication between the computers 3 and 8 is effected via the ISMTP protocol (Internet Short Message Transfer Protocol)... .” Paragraph 0050, lines 6 – 8. Thus, communications are conducted using the “inventive ISMTP protocol” as Guggisberg clearly indicates throughout. *See, e.g.*, paragraph 0051, lines 2 – 3 and paragraph 0052, lines 1 – 4. Paragraph 0053 in particular provides “an example is given in which a computer R1 sends a short message by means of the **inventive protocol** ISMTP to a computer R2.” Paragraph 0053, lines 1 – 3 (emphasis added). This is followed by a corresponding example (to the description of paragraph 0053) in more detail in paragraphs 0054 – 0066. However, Guggisberg neither mentions nor suggests using a browser, much less browser plug-ins in any of this.

Thus, while Guggisberg teaches “communication between the computers 3 and 8” using the “inventive ISMTP protocol,” Guggisberg does not teach plug-ins in a browser in either of the computers 3 or 8 forwarding SMS messages, e-mails or other types of messages to the remote phones 1, 2; much less “messaging redirector plug-ins for the browser program which each replace a corresponding messaging plug-in and are each assigned to a same said selected port to allow the digital telephone to log on to the computer workstation and each of said messaging

redirector plug-ins using a respective said selected port to forward selected messages to the digital telephone logged on to the workstation.” Claim 1, lines 7 – 11; see also similar language at claim 10, lines 7-11. Therefore, Guggisberg does not teach the present invention.

If for any reason this rejection under 35 U.S.C. §102(e) is to be maintained based on an alleged disclosure of the “messaging redirector plug-ins” at paragraphs 0050 – 0065 of Guggisberg, as is asserted in the present Office action, then, rather than a general citation to a paragraph as was done in the Office action, it is respectfully submitted that any rejection must be supported by citation to specific language (i.e., a quote) in any subsequent Office action, with a specific indication of location (indicating both paragraph and location within the paragraph) upon which the assertion is based, to allow the applicants adequate opportunity to respond. However, believing to have traversed the rejection, reconsideration and withdrawal of the rejection of claims 1 – 5 and 10 – 14 over Guggisberg under 35 U.S.C. §102(e) is respectfully solicited.

Regarding the rejection of claims 6 – 9 and 15 – 22 under 35 U.S.C. §103(a), Szlam is cited solely for teaching a PBX network. Further, it is asserted that “[i]t would have been obvious ... to combine the telephone network of Guggisberg with the PBX network of Szlam. A person of ordinary skill in the art would have been motivated to do this to allow the user to make long distance phone calls.” However, it is respectfully submitted that this falls far short of being a suggestion to combine under 35 U.S.C. §103(a). In finding obviousness “impermissible hindsight must be avoided and the **legal conclusion** must be reached on the basis of the facts gleaned from the prior art.” *MPEP* §2142 (emphasis added).

Thus, obviousness is based on a legal standard, not what one may feel with respect to the particular invention. “To support the conclusion that the claimed invention is directed to obvious subject matter, either **the references** must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the **teachings of the references.**” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (emphasis added). An obviousness rejection cannot be based on the resort to the combination of bits and pieces of the

references in the light of Applicants' teachings. An extensive discussion of the criteria to be applied in obviousness rulings is set forth in *Aqua-Aerobic Systems Inc. v. Richards of Rockford Inc.*, 1 U.S.P.Q. 2d 1945, 1955-57 (N.D. Ill. 1986). The fact that a prior art reference can be modified to show the patented invention does not make the modification obvious **unless the prior art reference suggests** the desirability of the modification. See *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). See also, *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Although a prior art device "may be capable of being modified to run the way [the applicant's] apparatus is claimed, there must be a suggestion or motivation **in the reference** to do so." 916 F.2d at 682, 16 USPQ2d at 1432 (emphasis added).). Furthermore, the MPEP §2143.01 provides in pertinent part that the

FACT THAT THE CLAIMED INVENTION IS WITHIN THE
CAPABILITIES OF ONE OF ORDINARY SKILL IN THE ART IS NOT
SUFFICIENT BY ITSELF TO ESTABLISH PRIMA FACIE OBVIOUSNESS

A statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some **objective reason** to combine the teachings of the references. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also... ; *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references.).

(emphasis added.) An objective reason has not been provided.

As has been previously noted, Szlam teaches a system and method that allows remote users to access on-site devices as if the user was, him/herself, on site. See, e.g., col. 3, line 36 – col. 6, line 8. A remote access controller (225 in Figure 1 and 2B) manages teleworker call connections. The remote access controller connects over the communications links 11 to the teleworker devices 10. See, col. 8, line 56 – col. 9, line 22. The only mention in Szlam of a PBX port is with respect to the hardware connection through the dual port telephone 211 of Figure 2A. "Port 211B is a telephone port that connects the telephone set 211 to the PBX 212. Port 211A allows a computer, such as a portable communications device 10, to place and receive telephone calls and to transfer data over the telephone line via the PBX 212." Col. 10, lines 62 – 67. No indication is given how one would modify this in Szlam to operate with the Guggisberg

“inventive ISMTP protocol,” which is key to combining Guggisberg with Szlam. After all, one would not combine Guggisberg with Szlam without including the heart of the Guggisberg invention. However, just connecting the Szlam “telephone set 211 to the PBX 212” and the Szlam PBX 212 to the Guggisberg telephone network “would render the prior art invention [Guggisberg and Szlam] being modified unsatisfactory for its intended purpose, [and so] there is no suggestion or motivation to make the proposed modification.” *MPEP* §2143.01 (citations omitted). “If the proposed modification or combination of the prior art **would change the principle of operation of the prior art invention being modified**, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).” *Id* (emphasis added). However, omitting the Guggisberg “inventive ISMTP protocol,” would change the principle of operation of Guggisberg and, therefore, the teachings of the references (Guggisberg and Szlam) are not sufficient to render the claims prima facie obvious.

Furthermore, Szlam does not teach “messaging redirector plug-ins for the browser program which each replace a corresponding messaging plug-in and are each assigned to a same said selected port to allow the digital telephone to log on to the computer workstation and each of said messaging redirector plug-ins using a respective said selected port to forward selected messages to the digital telephone logged on to the workstation” in claim 1 (and similar language in claim 10). Accordingly, Szlam in combination with Guggisberg does not result in the present invention as recited in claims 1 or 10, much less claims 6 – 9 and 15 – 22 depending therefrom. Therefore, claims 6 – 9 and 15 – 22 are patentable over the combination of Szlam with Guggisberg.

Accordingly, because without improper hindsight there is no suggestion or motivation to combine; because without improper hindsight there is no teaching how to modify and combine to result in the present invention; because to combine with Szlam, Guggisberg must be modified in a way that “would change the principle of operation of the prior art invention being modified;” and, because the combination still does not result in the invention, it is respectfully submitted that the present invention is not obvious under 35 U.S.C. § 103(a). Reconsideration and

withdrawal of the rejection of claims 6 – 9 and 15 – 22 under 35 U.S.C. § 103(a) over Szlam and Guggisberg is respectfully requested.

The applicants have considered the other references cited but not relied upon and find them to be no more relevant than the references upon which the Examiner relied for the rejection.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance for the reasons set forth above, the applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1 – 22 under 35 U.S.C. §§102(e) and 103(a) and allow the application to issue.

Should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the telephone number listed below for a telephonic or personal interview to discuss any other changes.

Respectfully submitted,

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(Date)

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